

**REMARKS**

**Summary of the Office Action**

Claim 33 stands rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,764,333 to *Somsel*.

Claims 34 and 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form.

Claims 1-32 and 36-39 are allowed.

**Summary of Response to Office Action**

Claim 33 is amended to more clearly define the invention.

Claims 1, 36, 38 and 39 are amended to correct typographical errors.

Claims 40 and 41 are added.

Accordingly, claims 1-41 are respectfully submitted for consideration by the Examiner.

**Rejections Under 35 U.S.C. § 102(b)**

Independent claim 33 stands rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,764,333 to *Somsel*. Applicants respectfully traverse the rejection for at least the following reasons.

Claim 33, as amended, is directed to a method for imaging eyeglasses including placing the eyeglasses *on an electronic imaging device* for imaging. This limitation is disclosed in Applicants' specification at, *e.g.*, page 11, line 23.

In contrast to the recited features of claim 33, as amended, *Somsel* discloses *manually* "laying a pair of eyeglasses 10 on a sheet of paper or other writing material 12 and tracing an outline of the lenses 14 of the eyeglasses." (*Somsel*, col. 3, ll. 1-8.) *Somsel* does not disclose using an electronic

imaging device to obtain the outline image of the eyeglasses. Accordingly, *Somsel* fails to disclose each and every feature of the invention as claimed.

For at least the above reasons, Applicants respectfully submit that claim 33, as amended, fully complies with the requirements of 35 U.S.C. § 102(b). Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. § 102(b) be withdrawn. Furthermore, Applicants respectfully submit that dependent claims 34 and 35 are allowable at least because of their dependence from independent claim 33 as amended and the reasons set forth above.

#### **Allowable Claims**

Claims 34 and 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim. Applicants present new independent claims 40 and 41 which incorporate all the limitations of original claims 34 and 35 and their base claim.

Claims 1-41 are in condition for allowance.

#### **Comments on Examiner's Reasons for Allowance**

In response to the Reasons for Allowance stated by the Examiner, while Applicants believe that all of the claims are allowable and patentably distinguish over the prior art, Applicants do not acquiesce that patentability resides in each of the listed features, exactly as expressed in the claims, nor that each and every feature is required for patentability.

**CONCLUSION**

Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the response, the Examiner is invited to contact the Applicants' undersigned representative to expedite prosecution.

If there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted

**MORGAN, LEWIS & BOCKIUS LLP**

By: 

Angela S. Robinson

Reg. No. 52,174

Dated: January 12, 2004

Customer Number 009629  
MORGAN, LEWIS & BOCKIUS LLP  
1111 Pennsylvania Avenue, N.W.  
Washington, DC 20004  
202-739-3000